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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,324

12/02/2003

Karl L. Ginter

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EXAMINER

SHAN, APRIL YING

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/727,324

Applicant(s)

GINTER ET AL.

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007 and 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-63 is/are pending in the application.
- 4a) Of the above claim(s) 42-59, 62 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-41, 60 and 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/04, 06/05, 11/05, 04/06, 09/06, 9/06.

### **DETAILED ACTION**

1. Claims 21-41 and 60-61 have been examined.

#### ***Election/Restrictions***

2. Applicant's election of Group I (Claims 21-41 and 60-61) in the reply filed on 27 November, 2007 is acknowledged. However, because the Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)).

Therefore, Group II (Claims 42-59 and 62-63) is hereby withdrawn.

#### ***Priority***

3. Applicant claimed the current application is a continuation-in-part of application No. 08/388,107 filed on Feb. 13, 1995, now abandoned.

Examiner had reviewed carefully the parent application (08/388,107). The parent application (08/388,107) only discloses generally a digital certificate as "Other installations 600 may trust the "certificate"....". However, the examiner discovered at least three claim limitations, receiving a first digital certificate from a user, the first digital certificate attesting to at least one attribute of the user, determining, based at least in part on the first digital certificate, whether the user is authorized to access the online service and if the user is authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service in the independent claim 1 of the current application are not supported by the parent application (08/388,107). Therefore, the examiner will not grant the priority date (Feb. 13, 1995) as claimed.

***Information Disclosure Statement***

4. The information disclosure statement filed 10 April 2006, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

5. Further, below references listed in the Information disclosure statement filed 23 November 2005 have been placed in the application file, but they are not considered since these references do not appear relevant with the instant application.

- U.S. Patent No. 3,946,200 – Proportional Temperature Controller
- U.S. Patent No. 4,727,550 – Radiation Source
- U.S. Patent No. 5,227,797 – Radar Tomography

***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “a computer readable medium” of claims 60-61 lacks antecedent basis in the specification. Please note **no** new matter is allowed to add the specification while addressing this issue.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 60-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per **claims 60-61**, "a computer program product stored on a computer-readable medium..." is being recited. However, it appears to be to one of ordinary skill in the art to reasonably interpret computer readable-medium as fairly conveying signals and other forms of propagation or transmission medium to one of ordinary skill in the art. Propagation medium, which is not a Manufacture within the meaning of 101, and electrical connections and optical fibers, on which the program is still unavailable to the processor. In such embodiments, the program instructions is still unable to act as a computer component and have its functionality realized.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 21-23, 26-27, 32-33, 36-41 and 60-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Sudia (U.S. Patent No. 5,659,616)

As per **claim 21**, Sudia discloses a method for providing access to an online service ("...electronic commerce business" – e.g. col. 4, lines 52-53), the method

comprising:

receiving a first digital certificate from a user, the first digital certificate attesting to at least one attribute of the user ("receiving a digital identifying certificate issued by a certifying authority and have a plurality of digital fields, at least one of said fields identifying said user" – e.g. claim 1);

determining, based at least in part on the first digital certificate, whether the user is authorized to access the online service ("When a recipient user (verifier) receives a transaction 51 from a sending user, the recipient first uses the sender's basic key certificate 55 to verify the sender's signature 52 on the transaction..." – e.g. col. 9, lines 36-40); and

if the user is authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service ("receiving a digital authorization certificate, separate from said identifying certificate and issued by a sponsor of said user, and authorizing transactions by said user..." - e.g. claim 1, "...the recipient also uses the sender's authorization certificate 56, signed by the sender's sponsor 59, to verify..." – e.g. col. 9, lines 36-45).

Please note further in col. 14, lines 5-18, Sudia also discloses "...it may often be helpful to the copy the user's public key out of his basic authentication certificate and include it as another attribute in an authorization certificate. This permits the authorization certificate to serve both purposes (authentication and authorization) and allows the sender to omit the basic authentication certificate from each transaction". It

is clear that in the Sudia reference, the authentication and authorization certificates are either two separate certificates or one authorization certificate to serve both authentication and authorization purposes.

As per **claims 22-23**, Sudia further discloses receiving a request from the user to access the online service ("...electronic commerce business" – e.g. col. 4, lines 52-53); checking the second digital certificate to determine whether the user has permission to access the online service ("verifying said transaction based on information in said identifying certificate and in said authorization certificate, said step of verifying including applying said rules...to verify..." - e.g. claim 1); and allowing the user to access the online service if it is determined that the user has permission to access the online service ("accepting said transaction based on said outcome of said verifying..." - e.g. claim 1) and in which said checking step is performed in a protected processing environment at a local computer system from which the user made the request to access the online service ("a system for securely using digital signatures in a commercial cryptographic system..." – e.g. abstract).

As per **claims 26-27**, Sudia further discloses providing a third digital certificate to the user, the third digital certificate attesting to the identify of the online service, the third digital certificate being issued by a certifying authority (e.g. col. 3, lines 48-67, col. 4, lines 10-38) and in which the first digital certificate is issued by the certifying authority



("receiving a digital identifying certificate issued by a certifying authority and have a plurality of digital fields, at least one of said fields identifying said user" – e.g. claim 1).

As per **claim 32**, Sudia further discloses in which the second digital certificate attests to the user's permission to access the online service until a specified date ("Certificates also contain an expiration date..." – e.g. col. 4, lines 1-9).

As per **claim 33**, Sudia further discloses in which the at least one attribute comprises an indication of the amount of purchases the user is allowed to make in a given time period (e.g. col. 11, lines 11-41).

As per **claims 36-37**, Sudia further discloses in which the online service comprises a subscription ("...into the attribute certificates of the CA and its subscribers.." – e.g. col. 7, lines 37-38) and in which the second digital certificate includes an expiration date of the subscription ("Certificates also contain an expiration date..." – e.g. col. 4, lines 1-9).

As per **claims 38-39**, Sudia further discloses collecting payment information from the user (e.g. col. 12, lines 1-18) and further comprising: sending the payment information to a financial clearinghouse (e.g. col. 6, lines 1-15 and col. 12, lines 1-18).

As per **claims 40-41**, Sudia further discloses collecting information relating to the user's use of the online service (col. 12, lines 1-18) and further comprising sending the information relating to the user's use of the online service to a usage clearinghouse (e.g. col. 6, lines 1-15 and col. 12, lines 1-18).

As per **claims 60-61**, Sudia discloses the claimed method of steps as applied above in claims 21 and 22. Therefore, Sudia discloses a computer program product stored on a computer-readable medium for carrying out the method of steps.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Arnold (U.S. Patent No. 5,956,408)

As per **claims 24-25**, Sudia does not expressly disclose sending software to the user. However, this well known feature is disclosed in col. 1, lines 10-14 of Arnold reference. It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Arnold's sending software to the user with Sudia since sending software to the user assures security (e.g. Arnold, col. 5, lines 1-14).

Arnold further discloses sending a digital signature for determining the integrity of the software to the user (Arnold, e.g. abstract) and in which the digital signature is bound, at least in part, to the identity of the online service (Arnold, e.g. abstract).

15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Boulton et al. (U.S. Patent No. 5,537,618)

As per **claim 28**, Sudia discloses a digital identifying certificate issued by a certifying authority and having a plurality of digital fields, at least one of said fields identifying said user (e.g. claim 1).

Sudia does not expressly disclose in which the first digital certificate includes an indication of the user's age.

However, it is well known at the time of the invention age is an attribute to identity a user. This well known feature is disclosed in col. 37, lines 32-34 of the Boulton et al. reference.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Boulton et al.'s age is an attribute to identity a user into Sudia since a user's age is one of the attributes that identifying the user.

16. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of examiner's official notice.

As per **claims 29-31**, Sudia does not expressly disclose the first digital certificate identifies a party responsible for paying for the user's access to online service and sending a request for payment to the party responsible for paying for the user's access to online services; and receiving an indication that payment has been received and in which the steps of (a) sending a request for payment and (b) receiving an indication that payment has been received are performed prior to performing the step of sending the second digital certificate to the user. However, Sudia discloses for example in fig. 6 monetary limit and further in col. 12, lines 1-5, an online banking system is disclosed. The examiner takes official notice that the above missing well known features are common knowledge at the time of the invention. It would have been obvious to a person with ordinary skill in the art at the time of the invention to combine the common

knowledge with Sudia since they are well known in the art to produce predictable results.

17. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Rebane et al. (U.S. Patent No. 5,978,567)

As per **claims 34-35**, Sudia does not expressly disclose in which the online service comprises an interactive online game.

However, this well known feature is disclosed in the abstract, col. 1, lines 48-64, col. 3, lines 22-31 and col. 8, line 66 – col. 9, line 12. It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Rebane et al.'s the online service comprises an interactive online game into Sudia since online service comprises an interactive online game is offered electronically and interactively is well known in the art. (e.g. Rebane et al., col. 1, lines 48-64).

Sudia-Rebane et al. further discloses sending software for playing the online game to the user in a secure container (Sudia, - e.g. abstract and Rebane et al. - e.g. col. 9, lines 37-52).

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In particular, reference Misra et al. (U.S. Patent No. 5,757,920), Shockley et al. (U.S. Patent No. 5,534,855), Misra et al. (U.S. Patent No. 5,999,711), Bisbee et al. (U.S. Patent No. 6,367,013), Fischer (U.S. Patent No. 4,868,877) and

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Haber et al. (U.S. Patent No. 5,373,561). Applicant is **strongly urged** to review these references in response to the current office action.

**Contact Information**

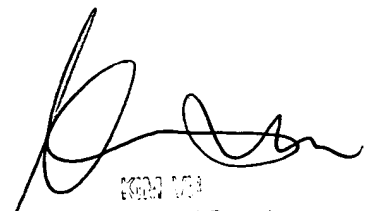
Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AYS

AYS  
3 February 2008

  
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